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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,730	08/09/2005	William R Blackwood	DC5018 PCT 1	6040

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/04/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary	Application No. 10/517,730	Applicant(s) BLACKWOOD ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 8, 10 to 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 8, 10 to 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/22/2010 has been entered.

2. Please note that this application has been transferred and is currently being examined by Examiner Margaret Moore.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 8 and 10 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al.

The basis for this rejection was noted in the previous office action. The Examiner adds the following comments only for emphasis. While the previous examiner specifically referred to Example XIII, this examiner also draws attention to Example I.

In both Examples I and XIII, the compositions contain the claimed components (B) and (C). Both compositions differ from that claimed in they contain a linear polysiloxane (Example I) or a MQ siloxane (Example XIII) rather than a siloxane (A) containing methyl T units. Note that both the linear and MQ siloxane contain 3 wt% OH groups (within the claimed range for (A)).

Column 2, lines 37 and 38, teaches that the siloxane containing OH groups can be, in the alternative to a linear or MQ siloxane, a predominantly monoorganopolysiloxane. From this one having ordinary skill in the art would have found the use of a monoorganopolysiloxane in place of either the linear or MQ siloxane in the working

examples to have been obvious. Such a siloxane meets (A) as claimed and rendered obvious the instant claims.

In the amendment dated 1/22/2010, applicants insert the language "consisting essentially of" into the claims. They argue that this limits the claims to the ingredients specified and other elements of "no essential significance". While it is unclear where applicants get this interpretation of "consisting essentially of" and it is unclear what would be considered an element of "no essential significance", the Examiner draws applicants' attention to MPEP 2111.03.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention.

There is nothing in the specification that would indicate that the presence of a pesticide materially affects the basic and novel characteristics of the claimed composition. In addition, the Examiner does not see how the presence of a pesticide would materially affect the fire or stain resistance of the claimed composition.

If an applicant contends that additional materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional components would materially change the characteristics of applicant's invention.

In addition, an argument that the pesticide is "of significance" in Young and would not be covered under Applicants' claims gives improper weight to the "consisting essentially of" language. It does not matter if the ingredient is required by the prior art; rather one must determine if the presence of the required ingredient in the prior materially affects the basic and novel characteristics *of the claimed invention*.

For this reason the instant claims remain obvious over the prior art.

With regard to claim 14, the Examiner notes that (contrary to that indicated in applicants' remarks) this claim still allows for masonry.

With regard to claim 15, the teachings on column 6, lines 30 and on, would suggest to the skilled artisan the application of the coating composition of Young et al. to any substrate that will subsequently be expected to come into contact with insects.

Art Unit: 1796

Note for instance that substrates such as buildings, walls, floors and cardboard boxes are disclosed. From this one having ordinary skill in the art would have been motivated to treat objects such as outdoor lawn furniture or umbrellas with the composition of Young et al., rendering obvious such substrates as textile fabrics (which are often made from fabrics).

On the other hand, cardboard is made from cellulose fiber, and thus meets the substrates in claim 15.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
2/26/10